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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,522	11/14/2003	Krishnan Chari	85501KNM	9951

7590

08/22/2006

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EXAMINER

HAQ, SHAFIQU

ART UNIT PAPER NUMBER

1641

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/713,522

Applicant(s)

CHARI ET AL.

Examiner

Shafiqul Haq

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

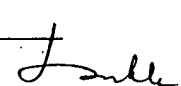
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC § 112 2nd.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-11.
Claim(s) withdrawn from consideration: 12-33.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____


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Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments and amendments filed 8/3/06 have been fully considered, and are persuasive to overcome rejections under 35 USC 112, but they are not persuasive to overcome the rejections under 35 USC 102 and 35 USC 103.

With respect to Applicants' argument that the present invention relates to a coating composition for making a protein microarray, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 195).

With respect to recitation "low fluorescent dye represented by the formula (I)", the low fluorescence property is inherent in the dye of Chen et al because water-insoluble Dye-1 (analogue of control dye-1) of Chen et al (paragraph [0025]) reads on Formula (II) of instant application. Both the dye have substantially the same structure and are expected to have the same property. The comparative dyes 1-4 of Table 1 of present application (page 21) as argued by applicants are different dyes (see page 22 and 23) and thus is not comparable with the dye (i.e. Dye-1) of Chen et al. Dye-1 of Chen et al. is substantially the same as the dye of present application and thus have similar property. MPEP §2112 states "[Where] the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established." *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977)(emphasis added).

Regarding the incorporation of claim language "wherein said coating composition is used to make a microarray", it is the examiner's position that this is intended use language. Applicant is reminded that a recitation of the intended use of the claimed invention, i.e. use to make a microarray, must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The incorporation of the phrase "wherein said coating composition is used to make a microarray" would also raise question under 112 second paragraph because it's unclear how the compound of formula (I) is used to make the microarray.

With respect to Applicants' argument for rejection under 35 USC 102 (*Evans et al*), the above argument is also applicable because *Evan et al* disclose dyes (see compounds 17-23) that reads on the dye of Formula (I) and Formula (II) of instant application. Moreover, silver "halide emulsion" also falls under the definition of microsphere i.e. minute sphere (spherical and non-spherical particles). Therefore, the reference still anticipates the cited claims.

In response to applicant's argument for 35 USC 103 rejections, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fines*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In this case *Noonal et al* ('575 patent), *Qiao et al* ('620 patent) and *Qiao et al* (US 2003/0224361) disclose magenta dye in the composition and *Evan et al* disclose that nickel metallized dye have less unwanted absorption than other metallizable dye (column 1, lines 30-35). Since nickel metallized magenta dye have added advantage (i.e. less unwanted absorption), it would be obvious to substitute other magenta dye (i.e. magenta dye of *Evans'* and *Qiao's*) with the nickel metallized magenta dye of *Evans et al.*, with the expectation to decrease unwanted absorption, with a reasonable expectation of success..